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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062400
Party	Plaintiff AvalonBay Communities, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AvalonBay Communities, Inc.,

Petitioner,

v.

Avalon IP Holding Co.,

Registrant.

Cancellation No. \_\_\_\_\_

Registration No.: 4043653

Registration Date: October 25, 2011

Trademark: AVALON

International Class: 43

**PETITION FOR CANCELLATION**

AvalonBay Communities, Inc. (“AvalonBay”), a Maryland corporation having its principal place of business at 671 N. Glebe Road, Suite 800, Arlington, VA 22203, believes that it is being damaged by U.S. Trademark Registration No. 4043653 for “Hotel and resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; reservation services for hotel room accommodations; restaurant and bar services” in International Class 43, and, through its attorneys, hereby petitions to cancel the entire registration pursuant to 15 U.S.C. § 1064 and 37 CFR § 2.111(b). As grounds for this petition, it is alleged that:

1. AvalonBay, including through its predecessors in interest, has been in the business of developing, redeveloping, acquiring and managing high-quality residential communities in the United States since at least as early as 1978.

2. On information and belief, Registrant Avalon IP Holding Co. (“Registrant”), a California limited liability company with an address of 1729 Abbot

Kinney Boulevard, Venice, California 90291, is the owner of U.S. Trademark Registration No. 4043653 for “Hotel and resort lodging services; provision of general purpose facilities for meetings, conferences and exhibitions; reservation services for hotel room accommodations; restaurant and bar services” in International Class 43 (“Registrant’s Services”). This registration issued on October 25, 2011.

3. Upon information and belief, Registrant operates a hotel that includes villa-style residences with full living rooms, dining rooms, and kitchens, as well as a pool and fitness area, much like many of AvalonBay’s apartment communities.

4. AvalonBay is the owner of numerous incontestable registrations incorporating AVALON (the “AVALON marks”), including the following:

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
AVALON PROPERTIES & Design	1,871,559	January 3, 1995	Class 36: Real estate investment trust services
AVALONBAY	2,618,414	September 10, 2002	Class 36: Managing, operating, leasing, appraising, brokering, investing in, and valuing real property; financial investment in the field of real property
AVALON & Design	2,799,153	December 23, 2003	Class 16: Paper, printed and cardboard articles, namely address labels, survey answer sheets on the subject of real property and residential services, printed charts; printed guides for real property; printed guides for residential services; periodical publications namely news letters, journals, and magazines relating to real property and residential services
AVALON & Design	2,887,466	September 21, 2004	Class 36: Real estate management, leasing, appraisal, investment, brokering, and valuation, and providing information on residential services in the management

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			and leasing of real estate via the Internet and e-mail; providing information on renter's insurance for residents and prospective residents Class 37: Real estate development, construction; residential building construction, repair and maintenance; planning and laying out of residential communities; real estate site selection; and providing information in the field of construction and development of residential buildings via the Internet Class 39: Providing information on storage space and moving for residents and prospective residents
AVALON COMMUNITIES	2,931,998	March 8, 2005	Class 36: Real estate management, leasing; providing information via the internet in the field of real estate management, leasing, appraisal, investment; providing information on rental insurance for residents and prospective residents of community properties Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities; real estate site selection; providing information on real estate in development and construction via the internet Class 39: Providing information on storage and moving for residents and prospective residents of community properties
AVALONBAY	2,950,374	May 10, 2005	Class 16: Printed guides for real property Class 36: Providing online information in the field of real property, namely investment information, providing links to other web sites concerning property management and property listings, renter's

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			insurance, multi-family housing management and residential support services, and neighborhood guides Class 37: Providing online information in the field of residential services, namely residential property construction and the planning of residential communities
AVALON COMMUNITIES & Design	2,950,378	May 10, 2005	Class 36: Managing, operating, maintaining, leasing and investing in real property; financial investment in the field of real property; providing online information for renters and prospective renters Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings Class 39: Providing information on storage and moving services for real property residents and prospective residents
AVALON COMMUNITIES & Design	2,950,379	May 10, 2005	Class 36: Providing information in the field of real property, namely, real estate management, leasing and residential property listings Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings
AVALON	3,101,896	June 6, 2006	Class 16: Paper and cardboard articles namely address labels, survey answer sheets, notebooks, picture books,

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			<p>calendars, announcement cards, blank cards, postcards, note cards, business cards, paper mats, printed charts, stationery, posters, signs; decals; drawing pencils; photographs; plastic bags; ball point pens; binders; bulletin boards; printed guides for real property; printed guides for residential services; periodical publications namely news letters, journals, and magazines relating to real property and residential services</p> <p>Class 35: Real estate marketing services, namely, providing advertising information on residential services for others</p> <p>Class 36: Managing, operating, maintaining, leasing, appraising, brokering, investing in, and valuing real property; purchasing real property for others; financial investment in the field of real property; providing online information for renters and prospective renters; providing information regarding real estate and rental insurance</p> <p>Class 37: Real estate development, construction and repair of buildings; planning and laying out of residential communities, real estate site selection; providing online information in the field of residential services, namely, real estate development, construction, maintenance and repair of buildings</p> <p>Class 39: Providing information on storage and moving services for real property residents and prospective residents</p> <p>Class 41: Providing online information and listings of the social events of others; providing information regarding community activities in the nature of social events</p>

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			Class 42: Providing information regarding architectural floor plans and furniture arrangement within floor plans Class 45: Providing online information regarding the security goods and services of others
AVALONBAY	3,154,668	October 10, 2006	Class 16: Posters Class 35: Real estate marketing services, namely providing online tours and images of residential real estate and other property
AVALON COMMUNITIES & Design	3,174,681	November 21, 2006	Class 16: Paper and cardboard articles namely calendars, postcards, posters, ball point pens; printed guides for real property; printed guides for residential services Class 41: Providing online information and listings of the social events of others Class 45: Providing online information regarding the security goods and services of others
AVALON COMMUNITIES & Design	3,419,667	April 29, 2008	Class 16: Ball point pens; printed guides for real property; printed guides for residential services Class 41: Providing online information and listings of the social events of others, namely, organizing, arranging, and hosting social events, get togethers, and parties for community members
AVALON COMMUNITIES	3,423,982	May 6, 2008	Class 35: Dissemination of advertising for others Class 36: Real estate appraisal, investment, and financial valuation
AVALON	3,523,079	October 28, 2008	Class 16: Printed guides for real property; Printed guides for residential support services and community information; periodical publications, namely, newsletters in the field of real property, residential support services, and community information Class 35: Providing online tours and

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			<p>images of real estate; providing online classified advertisements; real estate marketing services, namely, providing advertising information for others in the field of residential support services and community information; bringing together, for the benefit of others, a variety of goods and services to enable customers to conveniently view and purchase those goods and services</p> <p>Class 36: Multi-family housing management, namely, real estate management; residential support services, namely, managing and leasing real property; providing online information for renters and prospective renters of real property; and providing information regarding real estate and rental insurance</p> <p>Class 37: Real estate development, construction, and maintenance; and providing online information in the field of residential services, namely, maintenance and repair of buildings</p> <p>Class 41: Providing recreational and exercise facilities</p> <p>Class 42: Computer services, namely, providing an online community for social networking</p>

### **Grounds for Cancellation**

#### **Likelihood of Confusion**

5. AvalonBay has used its AVALON marks in connection with residential real estate and other services since at least as early as 1994, well before the filing of



Registrant's application to register the mark AVALON on October 29, 2008, and claimed first use date of July 31, 1999.

6. AvalonBay has undertaken significant efforts to actively promote its trademarks, including spending millions of dollars over the years in advertising and marketing the goods and services offered under the AVALON marks. Additionally, AvalonBay has been recognized numerous times and received multiple awards for high quality and excellence. It has received, among many other awards, the NAREIT Residential Leader in the Light Award, "Property Management Company of the Year" by the National Association of Home Builders, and the Multifamily Executive Awards' "Project of the Year" Award.

7. As a result of AvalonBay's continuous and extensive use, advertising and promotion of the AVALON marks, as well as the distinctiveness of the marks, the AVALON marks have become well-known, and consumers have come to recognize the AVALON marks as uniquely associated with AvalonBay and an indication of origin.

8. Registrant is not affiliated with or sponsored by AvalonBay, and Registrant has never been authorized by AvalonBay to use any of the AVALON marks.

9. Registrant's mark AVALON, which is registered under U.S. Trademark Registration No. 4043653 (the "AVALON registered mark") is identical to AvalonBay's AVALON mark and confusingly similar to AvalonBay's other AVALON marks. As such, consumers are likely to be confused, mistaken, or deceived into the belief, contrary to fact, that Registrant's Services offered under the AVALON registered mark emanate

from and/or are in some way sponsored or approved by AvalonBay, and/or that Registrant is somehow affiliated with AvalonBay, thereby damaging AvalonBay.

10. In addition, Registrant's Services are closely related to those offered by AvalonBay under its AVALON marks.

11. Registrant's Services are also likely to be sold to the same or overlapping classes of purchasers and trade channels as goods and services bearing the AVALON marks.

12. Because of the high degree of similarity between the parties' respective marks, services, and trade channels, as well as the fame of the AVALON marks in the real estate industry, Registrant's continued registration of the AVALON registered mark is likely to cause consumer confusion, mistake or deception, violating Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

### **Prayer for Relief**

13. On the basis of likelihood of confusion, U.S. Trademark Registration No. 4043653, is subject to cancellation under Section 14 of the United States Trademark Act of 1946, 15 U.S.C. § 1064.

14. AvalonBay believes that it is being damaged and will be damaged by the continued registration of the AVALON registered mark.

In view of the above, Registrant is not entitled to maintain a federal registration for the mark AVALON.

WHEREFORE, AvalonBay prays that said U.S. Trademark Registration No. 4043653 be cancelled in its entirety and that this Petition for Cancellation be sustained in

favor of AvalonBay. The appropriate fee is submitted herewith. Please direct all future correspondence to the undersigned.

Respectfully submitted,

By: /Brent D. Sokol/

Dated: October 6, 2015

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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the foregoing entitled  
Petition for Cancellation has been served on Registrant Avalon IP Holding Co. at the  
correspondence address of record in the United States Patent and Trademark Office by  
mailing said copy on October 7, 2015, via U.S. Mail, postage prepaid to:

Avalon IP Holding Co.  
1729 Abbot Kinney Boulevard  
Venice, California 90291



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Anna E. Raimer